



Paper No. 5

DARYL C. JOSEPHSON, ESQ.
SQUIRE, SANDERS & DEMPSEY L.L.P.
600 HANSEN WAY
PALO ALTO CA 94304

COPY MAILED

JUN 24 2002

OFFICE OF PETITIONS

| | |
|---------------------------------|-----------------------|
| In re Application of | : |
| DiLena et al. | : DECISION DISMISSING |
| Application No. 10/036,974 | : PETITION |
| Filed: 29 December, 2001 | : |
| Attorney Docket No. 42922.00048 | : |

This is a decision on the petition filed on 22 February, 2002 (certificate of mailing date 5 February, 2002) and supplemented on 26 February, 2002 (certificate of mailing date 4 February, 2002), requesting that the above-identified application be accorded a filing date of 28 December, 2001, instead of the presently accorded filing date of 29 December, 2001.

Petitioners request the earlier filing date on the basis that petitioners attempted to deposit the application in Express Mail service on 28 December, 2001, but that USPS employees refused to allow petitioners' counsel to deposit the application in Express Mail. Specifically, petitioners state that counsel arrived at the U.S. Post Office at San Francisco Airport ("SFO-PO") at 11:49 pm, on 28 December, 2001, prior to the 11:59 pm closing time. Counsel states that he entered the post office, but was told by USPS employees prior to his approaching the customer service window that the post office was closed. In pertinent part, petitioners' counsel states in his declaration:

4. I arrived at the SFO-PO, December 28, 2001, at 11:49 pm, entered the SFO-PO lobby, and attempted to enter the counter or "service" area of the SFO-PO carrying two packages, one including the above patent application, and filing papers, a self addressed, stamped postcard and a properly addressed mailing label for the patent application.

5. When I attempted to enter the service area of the SFO-PO, the door to the service area was unlocked and a USPS

agents behind the service area counter were accepting deposits from a small group of customers. No special closing time was visibly posted for December 28, 2001.

6. When I attempted to enter the service area of the SFO-PO, a USPS agent stopped me at the door, told me that the SFO-PO was closed, and refused my entry.

7. I alerted the USPS agent that the time was not yet 11:59 pm, that the package I carried was a legal document and patent application for which a postmark of December 29 was urgent and that my entry must be permitted in order to file and thereby preserve my client's rights. The USPS agent did not contest any part of my statement, but refused my entry telling me merely that the agents behind the counter did not want to serve me.

8. I further requested the USPS agent at the door to hand my package to a USPS agent behind the counter or another customer for deposit, noting that the label included my firm's charge account and completed addressing information. The USPS agents refused.

9. At that point, the USPS agents at the counter and then the USPS agent at the door instructed me to purchase stamps from a vending machine, affix the stamps and drop the stamped package in a drop box. Having no better option, I complied and deposited the stamped Express Mail envelope in the appropriate drop box for Express Mail before midnight.

10. After leaving the SFO-PO and upon arriving home, I further checked the official USPS web site, which posted a closing time for the SFO-PO as 11:59 pm. I could not locate a special SFO-PO closing time for December 28, 2001 on the web site.

Paragraph (a) of 37 CFR 1.10 states that:

Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be

accorded the Office receipt date as the filing date.¹

(emphasis added)

Paragraph (d) of 37 CFR 1.10 states that:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. Any statement submitted in support of such a showing pursuant to this paragraph must be a verified statement if made by a person other than an employee of the USPS or a practitioner as defined in § 10.1(r) of this chapter.

The present petition lacks items (2) and (3).

At the outset, it is noted that the Express Mail Label Number included with the petition is "EL701316235US" while the Express Mail Label Number found on the application papers received on 29 December, 2001, and assigned Application No. 10/036,974 is "EL701363487US". Obviously, in order for the above-identified application to be accorded a filing date of 28 December, 2001,

¹See 37 CFR 1.6(a).

petitioners would need to present a true copy of Express Mail Label No. EL701363487US showing a "date-in" of 28 December, 2001. It is additionally noted that the attorney docket number referenced on the petition filed on 22 February, 2002, and the accompanying Express Mail label is "42922.00106" while the attorney docket number appearing on the application transmittal sheet for the present application is "42922.00048". A review of Office records reveals that no application deposited in the name of the above-named inventor or with the title of the present invention bearing attorney docket number 42922.00106 was received on either 28 or 29 December, 2001. As petitioners have not presented any evidence that a package bearing Express Mail Label Number EL701363487US, the Express Mail number found on the application papers for the above-identified application, was deposited with the USPS on 28 December, 2001, the petition must be dismissed.

Moreover, assuming, *arguendo*, the correct Express Mail Label Number had been provided with the present petition, petitioner's bald assertion that the USPS arbitrarily refused to accept an Express Mail mailing is not persuasive evidence that the date-in was incorrectly entered. If the USPS did in fact refuse to accept counsel's Express Mail package, petitioners should contact the USPS and request an explanation. Any renewed petition, in addition to being accompanied by proof of attempted deposit of the correct Express Mail mailing, should include a letter from the USPS explaining why counsel was not permitted to deposit the application in Express Mail at the Customer Service window on 28 December, 2001, and stating the correct date of deposit of petitioners' application in USPS Express Mail Post Office to Addressee service. Lastly, petitioners have provided no evidence (e.g. a log book or letter to client after mailing) which came into being after deposit and within one business day of deposit.

Accordingly, the petition is dismissed.

The application is being returned to Office of Initial Patent Examination for further processing with the presently accorded filing date of 29 December, 2001.

Telephone inquiries may be directed to the undersigned at 703-308-6918.

A handwritten signature in cursive script, appearing to read "D Wood".

Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy